REMARKS

Claims 1-3, 5-8, 11-14, 16-17, 19-24, and 26-37 are pending in the present Application. By this Amendment, claim 26 has been amended, no claims have been cancelled, and no new claims have been added. Accordingly, claims 1-3, 5-8, 11-14, 16-17, 19-24, and 26-37 are currently at issue.

I. Objections to the Drawings and Specification

As described above, the amendments to the drawings are made to include reference numeral 34, which is described already in the specification. The amendments to the specification simply delete a superfluous word included inadvertently in the text, identified by the Examiner in the Office Action. Thus, these amendments do not introduce new matter. Applicants submit that these amendments fully address the Examiner's objections to the specification and drawings in paragraphs 2 and 3 of the Office Action. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw such objections.

II. Rejections Under 35 U.S.C. § 112

In paragraph 5 of the Office Action, the Examiner rejected claims 1-3, 5-8, 11-14, 16, 17, 19-24, 26, 28-35, and 37 under 35 U.S.C. § 112, as failing to comply with the enablement requirement. Applicants submit that the Examiner's rejections under this section are not warranted.

First, the Examiner articulates no basis for rejection of claims 1-3, 5-8, 11-14, 16, 17, 19-24, 35, and 37. The Examiner's rejections are based on confusion regarding Applicants' recital of a lock assembly having a "first configuration" and a "second configuration." Applicants respectfully point out that claims 1-3, 5-8, 11-14, 16, 17, 19-24, 35, and 37 do not require separate configurations of the lock assembly. Independent claim 1 is directed to a locking door assembly and only recites a single configuration, which includes an adaptor. Independent claim 11 is directed to a locking assembly and only recites a single configuration, which includes an adaptor. Independent claim 16 is directed toward the adaptor itself. Independent claim 35 is

directed to a door assembly and recites only a single configuration, which includes an adaptor. Independent claim 37 is directed to a door assembly and recites only a single configuration, which includes an adaptor. It appears that the confusion asserted by the Examiner is limited to independent claim 26 and the claims depending therefrom. Accordingly, Applicants respectfully request withdrawal of the Examiner's rejections of claims 1-3, 5-8, 11-14, 16, 17, 19-24, 35, and 37 under § 112.

Additionally, Applicants submit that claim 26, when read in connection with the specification, is clear with regard to the scope and meaning of the claim, and is fully supported and enabled by the specification. Applicants point the Examiner to the paragraph beginning on P. 8, Ln. 1 of the specification (emphasis added):

> In another embodiment of the invention, the assembly 10 includes a lock assembly 28 with structure that is adaptable between a first configuration (FIG. 1) whereby the axis of the extension bolt is in substantial alignment with the actuator axis (such as with that of prior assemblies as shown in FIG. 1), and a second configuration (FIG. 3) whereby the axis 62 of the extension bolt 36 resides a distance away from the actuator axis 40. Such alternating configuration is provided by a structure that allows optional use of the adaptor 60 as part of the connection 58 between the actuator 34 and the extension bolt member 36. If the user elects to have the extension bolt member 36 located along the lock edge 24 of the door 14, then the user links the connection 58 of the actuator 34 to the extension bolt 36 without the use of an adaptor having a length transverse either axis 40,62. Alternatively, if the user elects to configure the assembly 10 for an extent of extension bolt(s) 36 to pass through an interior portion of the door 14, spaced from the lock edge 24, then the connection 58 includes the adaptor 60 with the transverse length 82.

This paragraph completely and fully enables any person skilled in the art to practice the invention recited in claim 26. FIG. 1, as well as newly added FIGS. 12 and 13, illustrate the first configuration, where the assembly has a first extension bolt extending along a first bolt axis that is in substantial alignment with the axis of the actuator. FIGS. 3-6 illustrate the second configuration, where the assembly has a second extension bolt extending along a second bolt axis through an adaptor that spaces the axis of the actuator a distance away from the second bolt axis. The Examiner has articulated no reason why Applicants should be required to limit the scope of claim 26 to only the recited first configuration or second configuration. Claim 26 recites an "adaptable door lock assembly" that is adaptable between a first configuration and a second configuration, which incorporates the adaptor. One skilled in the art, given the above

disclosure, would understand that the lock assembly can be adjusted from one configuration to the other by the removal of the first extension bolt, the addition of the adaptor, and the connection of the second extension bolt. In such an adaptable door lock assembly, the same central lock unit can be used in either the first configuration or the second configuration, as described in the specification. Thus, claim 26 presents no problem with clarity and no enablement problem.

Applicants respectfully disagree with the Examiner's statement that, "it would appear that the invention is in the adaptor." Applicants submit that the invention recited in claim 26 is, at least in part, in the optional use of the adaptor to switch between the first configuration and the second configuration. Applicants also submit that claim 26, as written, recites this feature of the invention with sufficient clarity. Applicants further respectfully disagree with the Examiner's statement that claim 26 is unclear as to whether "the first and second configurations are used in the same assembly, i.e. the top bolt uses the adaptor and the bottom does not." Claim 26 clearly recites that both the first and second bolts, in their separate configurations, are connected to the same actuator. For the first and second bolts recited in claim 26 to be used simultaneously, they would have to be connected to two separate actuators.[1] Accordingly, claim 26 is clear in this regard as well. Applicant has made minor amendments to claim 26 that do not affect the above remarks.

In view of the foregoing, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of claims 26 and 28-34 under 35 U.S.C. § 112.

III. Rejections Under 35 U.S.C. § 102

In paragraph 7 of the Office Action, the Examiner rejected claims 1-3, 5, 8, 11-14, 16, 17, 19-22, 35, and 37 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,660,420 to Smith *et al.* ("Smith"). Applicants submit that claims 1-3, 5, 8, 11-14, 16, 17, 19-22, 35, and 37

[1] Applicants note that claim 26 does not explicitly exclude a configuration in which one bolt uses an adaptor and one bolt does not. Rather, the elements of claim 26 are directed to the configuration of the assembly with respect to a single actuator, and the configuration of the opposing actuator, if present, is not specified.

are patentable over Smith, and respectfully request the Examiner to reconsider and withdraw the rejections on this basis.

In order for a reference to constitute a §102(b) bar to patentability, the reference must disclose each and every element of the claimed invention. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771, 218 U.S.P.Q. 781, 789 (Fed. Cir. 1983). It is well-settled law that the burden of establishing a prima facie case of anticipation resides with the Patent & Trademark Office. *Ex Parte Skinner*, 2 U.S.P.Q. 2d 1788 (BPAI 1986).

Claim 1 includes, among other elements, "the extension bolt including an intermediate portion with a length extending generally transverse to said extension bolt axis and defining an extent of separation of the extension bolt axis from the actuator axis." Smith does not disclose at least this element of claim 1.

Smith discloses drive gear housing (11) with an axial drive device (15) extending therefrom, which is connected by a linking rod (16) to a locking pin (17). (Smith, Col. 2, Ln. 60-67; Col. 3, Ln. 14-16 and 32-35; FIG. 1). The Examiner asserts, in paragraph 7, that the drive device (15) is the recited "actuator," the locking pin (17) is the recited "extension bolt," and the linking rod (16) is the recited "adaptor," which spaces the locking pin (17) from the drive device (15). Assuming *arguendo* that the Examiner's interpretation is correct, Smith still does not disclose structure extending transverse to the extension bolt axis that defines an extent of separation of the bolt axis from the actuator axis. Smith discloses, as seen in FIG. 1, that the axes of the locking pin (17) and the drive device (15) are in substantial alignment, as in other prior art structures. The spacing between the locking pin (17) and the drive device (15) is not transverse to the locking pin, but rather, is axial in direction relative to the locking pin, and is not defined by any transversely-extending structure. Applicants further note that the Examiner has not identified the recited transverse structure in the Office Action. Accordingly, Smith does not disclose, teach, or suggest this element of claim 1, and Smith does not anticipate claim 1.

Claims 2, 3, 5, and 8 depend from claim 1 and include all the elements of claim 1. Thus, for the reasons articulated above with respect to claim 1, Smith does not anticipate claims 2, 3, 5, and 8.

Claim 11 includes, among other elements, "the body portion [of the adaptor] having a length extending generally transverse to the extension bolt axis to displace the extension bolt axis a distance away from the actuator axis." As discussed above with respect to claim 1, Smith does not disclose an adaptor extending transverse to the extension bolt axis to displace the extension bolt axis a distance away from the actuator axis. As discussed above, the axes of the locking pin (17) and the drive device (15) are in substantial alignment, as in other prior art structures. The spacing between the locking pin (17) and the drive device (15) is not transverse to the locking pin, but rather, is axial in direction relative to the locking pin, and is not defined by any transversely-extending adaptor. Accordingly, for the same reasons stated above with respect to claim 1, Smith does not anticipate claim 11.

Claims 12-14 depend from claim 11 and include all the elements of claim 11. Thus, for the reasons articulated above with respect to claim 11, Smith does not anticipate claims 12-14.

Claim 16 includes, among other elements, "the adaptor having a body length between said first end and said second end, said body length extending transverse to the elongated extension bolt, said length providing an extent of positioning the elongated extension bolt in spaced relationship from the actuator." As discussed above with respect to claim 1, Smith does not disclose an adaptor with a length extending transverse to the extension bolt to position the extension bolt in spaced relationship from the actuator. As discussed above, the axes of the locking pin (17) and the drive device (15) are in substantial alignment, as in other prior art structures. The spacing between the locking pin (17) and the drive device (15) is not transverse to the locking pin, but rather, is axial in direction relative to the locking pin, and is not defined by any transversely-extending length of an adaptor. Accordingly, for the same reasons stated above with respect to claim 1, Smith does not anticipate claim 16.

Claims 17 and 19-22 depend from claim 16 and include all the elements of claim 16. Thus, for the reasons articulated above with respect to claim 16, Smith does not anticipate claims 17 and 19-22.

Claim 35 includes, among other elements, "an adaptor connecting the actuator member and the extension bolt with a length extending generally transverse to said extension bolt axis and defining an extent of separation of the extension bolt axis from the actuator axis." As

discussed above with respect to claim 1, Smith does not disclose an adaptor with a length extending transverse to the extension bolt to separate the extension bolt axis from the actuator axis. As discussed above, the axes of the locking pin (17) and the drive device (15) are in substantial alignment, as in other prior art structures. The spacing between the locking pin (17) and the drive device (15) is not transverse to the locking pin, but rather, is axial in direction relative to the locking pin, and is not defined by any transversely-extending length of an adaptor. Accordingly, for the same reasons stated above with respect to claim 1, Smith does not anticipate claim 35.

Claim 37 includes, among other elements, "the body portion [of the adaptor] has a length extending generally transverse to the extension bolt axis to displace the extension bolt axis a distance away from the actuator axis." As discussed above with respect to claim 1, Smith does not disclose an adaptor with a length extending transverse to the extension bolt to displace the extension bolt axis from the actuator axis. As discussed above, the axes of the locking pin (17) and the drive device (15) are in substantial alignment, as in other prior art structures. The spacing between the locking pin (17) and the drive device (15) is not transverse to the locking pin, but rather, is axial in direction relative to the locking pin, and is not defined by any transversely-extending length of an adaptor. Accordingly, for the same reasons stated above with respect to claim 1, Smith does not anticipate claim 37.

Thus, Applicants respectfully request the Examiner to reconsider and withdraw the rejections of claims 1-3, 5, 8, 11-14, 16, 17, 19-22, 35, and 37 under § 102(b).

IV. Rejections Under 35 U.S.C. § 103

In paragraph 9 of the Office Action, the Examiner rejected claims 26, 28-34, and 36 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,209,931 to Von Stoutenborough *et al.* ("Von Stoutenborough") in view of Smith. Additionally, in paragraph 10 of the Office Action, the Examiner rejected claims 6, 7, 23, and 24 under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of U.S. Patent No. 1,094,143 to Hagstrom ("Hagstrom"). Applicants submit that the Examiner has not established a *prima facie* case of obviousness with respect to claims 6, 7, 23, 24, 26, 28-34, and 36.

It is the burden of the Patent and Trademark Office to establish a *prima facie* case of obviousness when rejecting claims under 35 U.S.C. §103. *In re Reuter*, 210 U.S.P.Q.2d 249 (CCPA 1981). To establish a *prima facie* case of obviousness, three basic criteria must be met: first, there must be some suggestion, incentive or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art references must teach or suggest all the claim limitations. *See In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1988). Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

A. Rejections Over Von Stoutenborough and Smith

Claim 26 includes, among other elements, "the adaptor body spacing the axis of the actuator a distance away from the second bolt axis ... said adaptor body having a length between the first and second ends, said length defining the distance said actuator axis is positioned away from the bolt axis." Applicants note that Claim 26 does not simply recite that the actuator is positioned away from the extension bolt, but that the axis of the actuator is positioned away from the axis of the extension bolt. As discussed above with respect to claim 1, Smith does not disclose a structure where the actuator axis is positioned away from the bolt axis. Rather, the axes of the locking pin (17) and the drive device (15) are in substantial alignment, as in other prior art structures. Accordingly Smith does not disclose, teach, or suggest this element of claim 26, and Applicants submit that Von Stoutenborough does not disclose, teach, or suggest this element either.

As seen in FIGS. 1-4 and 27-29, all of the embodiments described in Von Stoutenborough have an actuator and an extension bolt having axes in substantial alignment with each other, as in the recited first configuration. However, none of the embodiments show an extension bolt and an actuator that have axes positioned away from each other. Indeed, by relying on Smith to provide this element of claim 26, the Examiner has implicitly admitted that Von Stoutenborough does not disclose this element. Thus, neither Von Stoutenborough nor

Smith, alone or in combination, discloses, teaches, or suggests this element of claim 26, and the Examiner has not established a *prima facie* case of obviousness with respect to claim 26.

Claim 26 also includes, among other elements, a lock assembly having a first configuration and a second configuration. None of the cited prior art discloses, teaches, or suggests this element of claim 26. Even assuming *arguendo* that the Examiner is correct that Von Stoutenborough discloses the first configuration and Smith discloses the second configuration, neither reference discloses a single lock assembly having two different configurations. Further, neither reference provides any motivation for providing optional modification of the disclosed assembly to any different configuration. The Examiner has not identified any motivation for one skilled in the art to modify either of the disclosed assemblies to have two configurations. Accordingly, this element is also not disclosed, taught, or suggested by the cited prior art, and the Examiner has not established a *prima facie* case of obviousness with respect to claim 26.

Claims 28-34 depend from claim 26 and include all the elements of claim 26. Thus, for the reasons articulated above with respect to claim 26, the Examiner has not established a *prima facie* case of obviousness with respect to claims 28-34.

Claim 36 includes, among other elements, "the adaptor member spacing the axis of extension of the actuator a distance away from the second bolt axis." As discussed above with respect to claims 1 and 26, Smith does not disclose a structure where the actuator axis is spaced a distance away from the bolt axis. Rather, the axes of the locking pin (17) and the drive device (15) are in substantial alignment, as in other prior art structures. Accordingly Smith does not disclose, teach, or suggest this element of claim 36. As discussed above with respect to claim 26, Von Stoutenborough also does not disclose, teach, or suggest this element of claim 36. Thus, the Examiner has not established a *prima facie* case of obviousness with respect to claim 36.

Claim 36 also includes, among other elements, "selecting between installing the lock assembly in a first configuration and installing the lock assembly in a second configuration." None of the cited prior art discloses, teaches, or suggests this element of claim 36. Even assuming *arguendo* that the Examiner is correct that Von Stoutenborough discloses the first configuration and Smith discloses the second configuration, neither reference discloses selecting

between installing the lock assembly in one of these two configurations. Further, neither reference provides any motivation for providing optional modification of the disclosed assembly to any different configuration. In fact, the Examiner has not asserted that either reference discloses this selecting step, nor has the Examiner identified any motivation for one skilled in the art to make either of the disclosed assemblies selectable. Accordingly, this element is also not disclosed, taught, or suggested by the cited prior art, and the Examiner has not established a *prima facie* case of obviousness with respect to claim 36.

B. Rejections Over Smith and Hagstrom

Claims 6 and 7, via dependency from claim 1, include, among other elements, "the extension bolt including an intermediate portion with a length extending generally transverse to said extension bolt axis and defining an extent of separation of the extension bolt axis from the actuator axis." As described above with respect to claim 1, Smith does not disclose at least this element of claims 6 and 7. Hagstrom also does not disclose this element of claims 6 and 7, and the Examiner does not assert that the Hagstrom discloses this element. Further, there is no motivation to combine the assembly disclosed in Hagstrom with the assembly disclosed in Smith. In fact, the structure of the assembly disclosed in Hagstrom, particularly the connecting structure between components (38), (40), (41), (51), (54), (55), (56), and (53), is not compatible with the structure of the assembly disclosed in Smith. Accordingly, one skilled in the art would not combine the teachings of Smith and Hagstrom, and those references are not properly combinable to form an obviousness rejection. Thus, because the above element is not disclosed, taught, or suggested by the cited prior art, the Examiner has not established a *prima facie* case of obviousness with respect to claims 6 and 7.

Claims 23 and 24, via dependency from claim 16, include, among other elements, "the adaptor having a body length between said first end and said second end, said body length extending transverse to the elongated extension bolt, said length providing an extent of positioning the elongated extension bolt in spaced relationship from the actuator." As described above with respect to claim 16, Smith does not disclose at least this element of claims 23 and 24. Hagstrom also does not disclose this element of claims 23 and 24, and the Examiner does not

assert that the Hagstrom discloses this element. Further, there is no motivation to combine the assembly disclosed in Hagstrom with the assembly disclosed in Smith. In fact, the structure of the assembly disclosed in Hagstrom, particularly the connecting structure between components (38), (40), (41), (51), (54), (55), (56), and (53), is not compatible with the structure of the assembly disclosed in Smith. Accordingly, one skilled in the art would not combine the teachings of Smith and Hagstrom, and those references are not properly combinable to form an obviousness rejection. Thus, because the above element is not disclosed, taught, or suggested by the cited prior art, and Examiner has not established a *prima facie* case of obviousness with respect to claims 23 and 24.

V. CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration of the Examiner's rejections and allowance of Claims 1-3, 5-8, 11-14, 16-17, 19-24, and 26-37 in the present Application. Applicants further request reconsideration and withdrawal of the Examiner's objections to the drawings and specification. Applicants submit that the Application is in condition for allowance and respectfully request an early notice of the same.

Respectfully submitted,

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By: _____

Paul J. Nykaza, Registration No. 38,984
Gregory G. Schlenz, Registration No. 55,597
Banner & Witcoff, LTD.
10 S. Wacker Dr., Suite 3000
Chicago, IL 60606
312-463-5000

1166811